

Remarks

Introduction

This Reply is submitted in response to the Office Action mailed September 13, 2010. Claims 1-47 are pending with Claims 22-43 withdrawn and Claims 1-21 and 44-47 rejected.

Claims 1-4, 7-15, 17-21 and 44-47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2001/0021176 ("Mimura") in view of U.S. Patent No. 6,515,989 ("Rönneke") and in further view of U.S. Patent No. 6,947,408 ("Liberti").

Claims 5-6, and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Mimura, Rönneke, Liberti and in further view of U.S. Patent Publication No. 2002/0105911 ("Pruthi").

Applicants respectfully request reconsideration and allowance of all the pending claims, namely claims 1-21 and 44-47.

Applicants' Response to the 35 U.S.C. § 103(a) Rejections of the Independent Claims

A. Introduction

Independent Claims 1, 8, 12 and 18 are currently pending and were rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Mimura, Rönneke and Liberti taken in combination.

Claim 1 recites a packet data separator that facilitates providing a wireless data service by a service server. The packet data separator is configured to separate user packet data transmitted between the service server and a mobile communication exchange or a packet controller. Claim 1 also recites, *inter alia*, that the packet data separator is configured to receive the user packet data "only after an RP registration is provided." Independent Claims 8, 12 and 18 are similar to Claim 1 and likewise recite receiving the user packet data "only after an RP registration is provided."

Mimura suggests a "packet switch [that] identifies a communication flow carried across an IP network, observes the communication flow, and acquires statistics data thereof, such as the number of packets that passed through the switch, the number of discarded packets, time at which the packets arrived at the switch, and time at which the packets were sent out from the switch." Mimura, abstract.

As acknowledged in the previous Office Actions, “Mimura does not explicitly disclose using a wireless data service through a mobile communication network and does not disclose registering of subscriber’s device before using such service.” Office Action, page 9. To fill the void of Mimura, the Examiner cites Rönneke, and alleges that Rönneke “discloses a mobile communication network with architecture that inter-works with existing packet data networks and provides data series to subscriber’s mobile station” Office Action, page 4.

The Office Action also notes that Mimura and Rönneke “fail to explicitly teach receiving the user data packet only after RP registration is provided as further recited in the claim.” Office Action, page 4. Liberti is cited as allegedly showing, “receiv[ing] the user packet data only after RP registration is provided” Office Action, page 4.

B. The Mimura-Rönneke-Liberti combination fails to suggest each recitation of Applicants’ independent claims.

In rejecting Applicants’ independent Claims 1, 8, 12 and 18, the Examiner likens registering Liberti’s “RPs 110” with a subscriber unit to Applicants’ claimed “RP registration.” *See, e.g.*, Office Action, page 4. Applicants respectfully submit that registering with Liberti’s RPs 110 are different than Applicants’ claimed “RP registration.”

Applicants’ claimed “RP registration” is shown in the Applicants’ drawings as being performed with a packet data serving node (“PDSN”) and a subscriber device. *See, e.g.*, Applicants’ FIGS. 10 and 17. In such instances, it is well known by those skilled in the art that “RP” is an acronym for “Radio-PDSN interface.” In this regard, the claimed “RP registration” refers to the subscriber device’s registration with a PDSN.

In Liberti, “RP” is an acronym for “Radio Port.” Liberti, Col. 3, lines 26-27. Liberti’s “RPs 110 establish radio or wireless links with a plurality of subscriber units (SUs) 105, and also manage the termination and modification to the links.” Liberti, Col. 3, lines 30-32. “At least one of the RPs 110 in each subnet 120 includes mobility agent (MA) functionality, shown as MA 115 in FIG. 1.” Liberti, Col. 3, lines 27-29.

As such, if each of Liberti’s RPs 110 could be likened to anything discussed in Applicants’ disclosure, it would be Applicants’ base transceiver station (“BTS”) and/or base station controller (“BSC”). Applicants’ BTS/BSC “guarantees mobility of a subscriber 100, and it is a wireless network for performing a handoff operation and a wireless support and

management operation. The BTS is a network terminal for processing baseband signals, converting wired and wireless signals, and transmitting and receiving wireless signals to be connected to the subscriber 100, and the BSC is provided ... to manage and control base stations.”

Accordingly, at least because Liberti fails to show or suggest Applicants’ claimed “RP registration,” Liberti, like the other documents of record, fails to explicitly suggest a “packet data separator [being] configured to ... receive the user packet data only after an RP registration is provided,” as recited by Applicants’ independent Claim 1. Independent Claims 8, 12 and 18 are similar to Claim 1 and likewise recite receiving the user packet data “only after an RP registration is provided.” Therefore, independent Claims 1, 8, 12 and 18 are patentable over any proper Mimura-Rönneke-Liberti combination.

C. The Mimura-Rönneke combination can be rebutted.

Applicants previously noted that Mimura teaches away from Rönneke. The Examiner’s most recent response to this has two parts. First, the Examiner provides an explanation why a teaching, suggestion or motivation to combine references may be used to establish obviousness and, second, the Examiner notes that Mimura and Rönneke are analogous art. *See, e.g.*, Office Action, pages 16-17.

Applicants respectfully submit, that while those two things may be used to establish a *prima facie* case of obviousness, the *prima facie* case of obviousness can be rebutted by showing the references teach away from Applicants’ claim recitations and/or the combination proposed by the Examiner.

“A *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)” MPEP § 2144.05.III. “It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).” MPEP § 2145.X.D. See also MPEP §§ 2141.02 and 2141.03.

Rönneke teaches away from Mimura, because Rönneke would be rendered useless for its intended purpose if Rönneke were combined with Mimura as suggested in the Office Action. The entire thrust of Rönneke is to have a Billing Data computing resource *separate from a*

traffic function computing resource. See, e.g., Rönneke, col. 4, lines 45-49. As such, Rönneke would be rendered useless if its Billing Data computing resource was integrated into an existing or well known traffic monitoring resource, such as Rönneke's traffic function computing resource 38 or Mimura's packet switch. In other words, the intended purpose of Rönneke is to provide a Billing Data computing resource that is designed to work in parallel with a traffic monitoring component, not to be combined with something like Mimura's packet switch. See, e.g., Rönneke, FIG. 2.

Moreover, even if the Examiner finds a document to replace Mimura, Applicants would kindly ask the Examiner to consider in advance why that new document may be combined with Rönneke without rendering Rönneke useless for its intended purpose. Rönneke makes clear that its intended purpose is to provide a packet switch and Billing Data computing resource that are two separate components that operate in parallel.

Because it goes against the teachings of Rönneke to integrate some of its Billing Data computing resource functionality in something like Mimura's packet switch, Rönneke cannot be properly combined with Mimura, such that the rejections based upon a combination of Mimura and Rönneke are traversed for this reason as well.

D. Summary of responses to rejections of independent claims.

For at least these reasons, namely the documents of record not showing or otherwise suggesting every recitation of Applicants' independent claims and the Applicants' rebuttal of the Examiners' *prima facie* case of obviousness, the documents of record fail to render independent Claims 1, 8, 12 and 18 unpatentable. Thus the rejections of independent Claims 1, 8, 12 and 18 should be withdrawn and the claims should be allowed.

Reply to Rejections of Dependent Claims 2-7, 9-11, 13-17, 19-21 and 44-47

For at least the foregoing reasons, independent Claims 1, 8, 12 and 18 are patentable and, since Claims 2-7, 9-11, 13-17, 19-21 and 44-47 depend from and necessarily include all of the recitations of one of independent Claims 1, 8, 12 and 18, the cited documents, whether taken alone or in combination, do not teach or suggest the system and methods of Claims 2-7, 9-11, 13-17, 19-21 and 44-47 for at least the same reasons as described above in conjunction with the respective independent claims. ("If an independent claim is nonobvious under 35 U.S.C. § 103,

then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.) Accordingly, it is therefore submitted that the 35 U.S.C. § 103(a) rejections of Claims 2-7, 9-11, 13-17, 19-21 and 44-47 have been overcome.

Conclusion

In view of the remarks presented above, Applicants submit that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicants’ undersigned attorney in order to resolve any remaining issues.

It is believed that no extension of time or additional fees are required. However, in the event that any additional extension of time and/or other fees are necessary to allow consideration of this Reply, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims and the Request for Continued Examination) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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